

REMARKS

Applicant thanks the Examiner for the courtesy of conducting a telephone interview on January 11, 2005. In the interview, the above claim amendments relating to the inner or protected surfaces facing each other were discussed and the Examiner indicated that such amendments would probably overcome the §102(a) rejection, but that he would still have to consider §103. No agreement as to the allowability of the claims was reached in the interview, and an Advisory Action was mailed on January 19, 2005. The Advisory Action indicated the proposed amendment of January 11, 2005 would not be entered. Accordingly, the presently submitted claims are marked in comparison to the claims as they stood after the amendment mailed on July 19, 2004.

Independent claims 1, 6 and 11 have been amended to more precisely define the “inner portion” of the tool handle of the claim, and to specify that the inner surfaces of the handles of the tool are convex relative to one another. This latter feature is now being presented to the Examiner for the first time. It is believed that this clarification better differentiates claims 1, 6 and 11 from the cited art, Bond, U.S. Patent No. 5,421,224 (the ‘224 patent). Bond does not disclose indicia on a surface of a tool that is protected from wear. Furthermore, the tool shown in Bond comprises handles that curve toward each other, thus negating the applicability of Applicant’s invention to the Bond handles.

During the interview, the Examiner opined that the amended claims are obvious in view of Bond ‘224, particularly because Bond has indicia (70) on a blunt end (72) of a handle. The Examiner indicated that the placement of indicia (70) on the end of the tool implies that Bond suggests protecting the indicia (70) from abrasion and wear.

We question the underlying premise that the indicia 70 is in a protected location. We believe that the way pliers are used the blunt ends are still going to be subjected to wear, both as the tool is misused for pounding and as a palm of a user's hand presses on the end to impart a driving force. At most the indicia 70 may be somewhat less susceptible to abrasion than the indicia 68, 69. In any event, just because indicia 70 is not in the worst possible wear-related position, it does not follow that Bond suggests indicia protection in the manner achieved in the present invention.

We respectfully disagree that Bond discloses any inclination toward protecting the indicia. This is demonstrated by the fact that Bond contains no mention at all of indicia protection. The fact that Bond has no mention of indicia protection is understandable in view of the nature of the tools with which he is primarily concerned, namely screwdrivers. A screwdriver handle has no surface that is invulnerable to contact with a user's hand. Even the butt end will commonly be engaged by a user's palm as a user attempts to impart axial driving force to the tool. The placement of indicia 70 on the end of the pliers in Bond is merely emulation of the indicia position on the screwdriver. It is not a teaching that protection of the indicia is enhanced.

Bond's sole focus is identification of the tool—he is not concerned with protecting the indicia. Only Applicant's disclosure provides any motivation for protecting the indicia. Thus, the Examiner's suggestion that it would be obvious to translate the indicia (70) from the end of the pliers to an inner surface is misplaced. Such a modification of Bond would be motivated only by Applicant's disclosure. Bond does not recognize that with respect to abrasion resistance the indicia (70) may be in a better position than the indicia (68, 69). In fact, the only tool in Bond that provides a sheltered

position on the tool is the pliers of Fig. 8, and in this tool, Bond did not choose to utilize the sheltered location.

In addition, even if locating Bond's indicia (72) on the blunt end of a pliers is arguably better than the indicia (68, 69) on the sides, it does not follow that Bond recognizes that improvement or in any way sought to achieve indicia protection. With no motivation from Bond to protect the indicia, there is further no motivation to make the next improvement by moving the indicia to the physically sheltered location of the inner surface of the pliers handle. Only by importing the motivation from Applicant's disclosure would one recognize that Bond could be further improved by sliding the indicia off of the end of the tool and onto the inner surface.

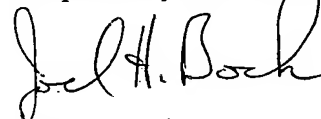
Finally, it is believed that the shape of Bond's handles forecloses the notion that Bond would render obvious the relocation of the indicia onto the inside surfaces of the handle. Note that Bond's handles are curved toward one another. With that shape an indicia on the inside of the handles would not be visible from above; the curved handles would block the line of sight. Such an indicia would be useless, as it would not be possible to see it. The curvature of the handles would obscure the indicia. Accordingly, the very purpose of the indicia, namely quick identification of the tool type while it rests in a tool pouch or on a tool belt, would be defeated in Bond if the indicia were placed on the inside surfaces of the handles. In contrast, the Applicant's tool comprises handles with inner surfaces that are convex relative to one another. That is, the ends of the handles flare away from each other. This exposes the inner surfaces to viewing from above, allowing a user to view indicia located on the inner surface of the handle. At the

same time the indicia less susceptible to wear because a user's hand will not contact the indicia.

We submit that it cannot be obvious to modify the location of the indicia in Bond when doing so hides the indicia inside the concave handles and renders the indicia useless. Accordingly, the position that Bond renders obvious a relocation of the blunt end indicia in Bond to the inside surface is improper because doing so would defeat the purpose of the indicia. All of the independent claims have been amended to specify that the handles have inner surfaces which are convex relative to one another. Bond does not show such a structure.

It is submitted that the above amendments place the application in condition for allowance. Accordingly, the application is resubmitted for reconsideration. A favorable action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joel H. Bock". The signature is fluid and cursive, with the first and last names being more prominent.

Joel H. Bock

Registration No. 29,045

Cook, Alex, McFarron, Manzo,
Cummings & Mehler, Ltd.
200 West Adams St.
Suite 2850
Chicago, IL 60606
Phone: (312) 236-8500
Fax: (312) 236-8176